



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,780	11/26/2003	Richard T. Raines	023880-6	5086
22204 7590 12/20/2006 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER ZURITA, JAMES H	
			ART UNIT 3625	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/721,780

Applicant(s)

RAINES ET AL.

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-125 is/are pending in the application.
- 4a) Of the above claim(s) 1-51, 93-112, 119-125 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-92 and 113-118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: _____                                     |

## **DETAILED ACTION**

### ***Response to Election/Restrictions***

On 29 September 2006, applicant elected Group II, claims 52-92 and 113-118.

Applicant traversed the requirement on the grounds that:

... the different groups identified by the Examiner are all classified in the same Class 705, and Subclass 37. In addition, various limitations of the claims between the different groups overlap...Analogous parallels are also present with respect to the system and computer readable medium claims as filed.

...thorough search for the subject matter of the provisionally elected Group II in the same class and subclass would also include the subject matter of Groups I, III, and IV as well. Therefore, the search and examination of the entire application can be made in the same class and subclass without serious burden to the Examiner. (See M.PEP 803).

The Examiner respectfully disagrees and notes that applicant nowhere asserts that the various embodiments are obvious variations over another, although applicant appears to agree that the inventions are not patentably distinct.

The Examiner also respectfully disagrees with applicant's comments that such searches would not be overly burdensome. The Examiner respectfully notes that the Office requires that Examiners search claims without limiting searches to particular classes and subclasses. Thus, any search must include various types of searches, including textual searches and image searches of all classes and subclasses in each of multiple databases of US patents, PG-PUBS, foreign patents non-patent literature, the Internet and Internet archives.

The requirement is still deemed proper and is made FINAL.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Please provide publication date of each reference. Date printed is not sufficient to evaluate if the references anticipate the application.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "38" and "28" have both been used to designate price adjustment database. For example:

Fig. 2 refers to price adjustment database as item **28**.

On page 21, paragraph 0059 refers to price adjustment database **38**.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the

changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 52-56, 58-59, 62, 63, 75-80, 113-117 are rejected under 35

U.S.C. 102(b) as having been in use or on sale at least one year prior to 26 November 2003, as evidenced by Brown, Just How Used is That Used Car? The Washington Post, 18 August 1997 and Meredith Little, Buying and selling a car online. Mac@Home. Louisville: Sep 1999. Vol.4, Iss. 9; pg. 4, 6 pgs, downloaded from the Internet on 10 December 2006.

**As per claim 52**, Brown discloses methods for adjusting a price of a used vehicle comprising the steps of:

- obtaining a plurality of vehicle history datasets relating to a plurality of vehicles, each of said datasets having vehicle history attributes regarding a particular vehicle (see, for example, at least page 1, paragraphs 2 and 3);
- obtaining a plurality of transactional records relating to sale transactions of a plurality of vehicles, each transaction record including at least one of a date and a

transaction price (see, for example, at least page 3, paragraph 23, which discloses transaction history relating to multiple owners); and

- determining price adjustment values for said vehicle history attributes based on said vehicle history datasets and said transaction records (see, for example, paragraph 21, and references to taking a loss using a car's history that reveals rolled back odometer).

**As per claim 53**, Little discloses displaying said price adjustment values for said used vehicle. See Little, Figs. C and G.

**As per claim 54**, Little discloses obtaining a base price for said used vehicle from a used vehicle valuation service. In *Little*, see references to Edmunds, carfax.

**As per claim 55**, Little discloses adjusting said base price for said used vehicle based on said vehicle history attributes regarding said used vehicle using said determined price adjustment values. See Little, page 4, second to last paragraph.

**As per claim 56**, Little discloses displaying said adjusted base price for said vehicle. See, for example, *Little*, page 4, Fig. C.

**As per claim 58**, Brown discloses determining which sale transactions of said plurality of transaction records occurred with buyer's knowledge of said vehicle history attributes, and which sale transactions of said plurality of transaction records occurred without buyer's knowledge of said vehicle history attributes. See paragraph 20, page 3.

**As per claim 59**, Brown discloses determining price adjustment values for said vehicle history attributes is attained further based on whether sale transactions of said

plurality of transaction records occurred with buyer's knowledge of said vehicle history attributes. See, for example, Brown, page 3, paragraph 23.

Claims 62 and 63 are rejected on the same grounds as claim 58.

Claim 75 is rejected on the same grounds as claim 52.

Claim 76 is rejected on the same grounds as claim 53.

Claim 77 is rejected on the same grounds as claim 54.

Claim 78 is rejected on the same grounds as claim 55.

Claim 79 is rejected on the same grounds as claim 56.

Claim 80 is rejected on the same grounds as claim 58.

Claim 113 is rejected on the same grounds as claim 52.

Claim 114 is rejected on the same grounds as claim 54.

Claim 115 is rejected on the same grounds as claim 55.

Claim 116 is rejected on the same grounds as claim 56.

Claim 117 is rejected on the same grounds as claim 58.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57, 60-61, 64-74, 81-92, 118 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown and Little.

Brown and Little **do not** specifically disclose details of storing adjustment values according of attributes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Brown and Little to disclose storing adjustment values according to attributes (claim 60) based on vehicle history (claim 61) according to whether a user is aware or not aware (claim 64), determining an average transaction price (claim 65), with parameters including at least one of mileage, color, location and options of said type of vehicle in said transaction records (claim 66), identifying at least one transaction record for said type of vehicle in said transaction records classified in said Known Class that have the same vehicle parameters (claim 67), calculating a price differential between transaction price associated with said at least one transaction. record in said Known Class, and said determined average transaction price for said type of vehicle in said transaction records classified in said Not Known Class (claim 68) determining price adjustment values for said vehicle history attributes is attained by attributing said price differential to said vehicle history attributes in said at least one transaction record in said Known Class (claim 69).

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Brown and Little to disclose storing adjustment values according to attributes (claim 60) based on vehicle history (claim 61) according to whether a user is aware or not aware (claim 64), determining an average transaction price (claim 65), with parameters including at least one of mileage, color, location and options of said type of vehicle in said transaction records (claim 66), identifying at least one transaction record for said type of vehicle in said transaction records classified in



said Known Class that have the same vehicle parameters (claim 67), calculating a price differential between transaction price associated with said at least one transaction record in said Known Class, and said determined average transaction price for said type of vehicle in said transaction records classified in said Not Known Class (claim 68) determining price adjustment values for said vehicle history attributes is attained by attributing said price differential to said vehicle history attributes in said at least one transaction record in said Known Class (claim 69) for the obvious reason that a buyer may thus rely more on specific aspects of a used vehicle prior to purchase and feel more comfortable with his purchase.

As per claim 71, Brown discloses Performing multivariate analysis to compute price adjustment values for said vehicle history attributes in said plurality of transaction records. *Brown*, paragraph 37.

Brown and Little do not specifically disclose that said at least one transaction record in said Known Class is a plurality of transaction records in said Known Class, and said method further includes determining price differentials between each of said plurality of transaction records in said Known Class and said determined average transaction price (claim 70), that the plurality of transaction records in said Known Class from which price differentials are determined are transaction records for the same type of vehicle having the same vehicle parameters as said transaction records classified in said Not Known Class from which said average transaction price is determined (claim 72) that transaction records classified in said Not Known Class are windowed to be

within a predetermined time (claim 73) and that the window is not greater than one year of said at least one transaction record in said Known Class (claim 74).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Brown and Little to disclose that said at least one transaction record in said Known Class is a plurality of transaction records in said Known Class, and said method further includes determining price differentials between each of said plurality of transaction records in said Known Class and said determined average transaction price (claim 70), that the plurality of transaction records in said Known Class from which price differentials are determined are transaction records for the same type of vehicle having the same vehicle parameters as said transaction records classified in said Not Known Class from which said average transaction price is determined (claim 72) that transaction records classified in said Not Known Class are windowed to be within a predetermined time (claim 73) and that the window is not greater than one year of said at least one transaction record in said Known Class (claim 74).

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Brown and Little to disclose that said at least one transaction record in said Known Class is a plurality of transaction records in said Known Class, and said method further includes determining price differentials between each of said plurality of transaction records in said Known Class and said determined average transaction price (claim 70), that the plurality of transaction records in said Known Class from which price differentials are determined are transaction records for the same type

Art Unit: 3625

of vehicle having the same vehicle parameters as said transaction records classified in said Not Known Class from which said average transaction price is determined (claim 72) that transaction records classified in said Not Known Class are windowed to be within a predetermined time (claim 73) and that the window is not greater than one year of said at least one transaction record in said Known Class (claim 74) for the obvious reason that varying the price of a used vehicle according to its characteristics permits a buyer to better evaluate whether he wants to buy the car or not, and if the used car had too many problems.

Claim 81 is rejected on the same grounds as claim 64.

Claim 82 is rejected on the same grounds as claim 65.

Claim 83 is rejected on the same grounds as claim.

Claim 84 is rejected on the same grounds as claim

Claim 85 is rejected on the same grounds as claim 70.

Claim 86 is rejected on the same grounds as claim 71.

Claim 87 is rejected on the same grounds as claim 72.

Claim 88 is rejected on the same grounds as claim 73.

Claim 89 is rejected on the same grounds as claim 53.

Claim 90 is rejected on the same grounds as claim 54.

Claim 91 is rejected on the same grounds as claim 55.

Claim 92 is rejected on the same grounds as claim 53.

Claim 118 is rejected on the same grounds as claim 71.

***Conclusion***

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

The attached document 10\_721780\_screens shows that the **carfax** website has been active since at least December 1988. Please provide materials disclosing the dates that the claimed features were introduced.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**James Zurita**  
**Primary Examiner**  
**Art Unit 3625**  
12 December 2006

*James Zurita*  
*Primary Examiner*